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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/862,917	05/22/2001	Michael Jarman	78104.073	8732

25005 7590 07/08/2009

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EXAMINER
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BORISSOV, IGOR N

ART UNIT	PAPER NUMBER
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3628

NOTIFICATION DATE	DELIVERY MODE
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07/08/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docket-ip@dewittross.com

<b>Office Action Summary</b>	<b>Application No.</b> 09/862,917	<b>Applicant(s)</b> JARMAN ET AL.	
	<b>Examiner</b> Igor N. Borissov	<b>Art Unit</b> 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21, 23-26, 28 and 35-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21, 23-26, 28, and 35-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 05/04/2009 has been entered.

### ***Response to Amendment***

Amendment received on 05/04/2009 is acknowledged and entered. Claims 22, 27 and 29-34 have been canceled. New claims 43-45 has been entered. Claims 1-21, 23-26, 28, and 35-45 are currently pending in the application.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-12, 14-21, 23, 28 and 35-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Synesiou et al. (US 5,959,549) in view of Sloan et al. (US 5,146,067) and further in view of Official Notice.**

#### **Independent claims**

Claims 1, 37 and 42. Synesiou et al. teaches a utility transaction authorization system, comprising:

a user interface unit (display unit) capable of accepting a card charge authorization (C. 5, L. 15-24, 44-60);

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a utility meter (remote measurement module 38) provided at a location having an associated location identifier (unique identification number) unique to the location (C. 4, L. 16, 30-36);

wherein the utility meter (remote measurement module 38) is arranged to:

communicate with the user interface unit (display unit), to obtain a card charge authorization (C. 5, L. 55-57);

to transmit card charge request to a financial institution based on the card charge authorization (C. 5, L. 52-57) and meter location identifier (the utility meter unique identification number and module address code is stored in microcontroller 68, which allows the consumption data derived from a particular consumer site to be related to that site and to the credit data corresponding to that site) (C. 4, L. 49-53),

the card charge request including:

(1) data identifying a credit/charge card account (C. 5, L. 55-57), and

(2) data related to the credit/charge card (a card number and a secret code or PIN allocated to the consumer) (C. 5, L. 53-54),

to obtain authorization of the card charge from the financial institution (C. 5, L. 52-57).

Synesiou et al. does not specifically teach that said data related to the credit/charge card is data indicating that the credit/charge card is physically present at the location of the user interface unit. Also, Synesiou does not teach that the financial institution processes the card charge request from the utility meter regardless of whether the card charge request relates to any utility usage measurements made by the utility meter.

Sloan et al. (Sloan) teaches a prepayment system for dispensing utilities using mag-stripe cards, including a means for reading a mag-stripe card provided at the customer's side (premises) for allowing to dispense utility services in accordance with the value and account information encode' on the mag-stripe card (Cls. 3, 4), wherein the fact of using the mag-card (obtaining data from the mag-card) at the customer premises indicates that the mag-card (credit/charge card) is physically present at the location of the user interface unit.

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In this case, each of the elements of the cited references combined by the Examiner performs the same function when combined as it does in the prior art. Thus, such a combination would have yielded predictable results. See *Sakraida*, 425 U.S. at 282, 189 USPQ at 453. Therefore, Supreme Court Decision in *KSR International Co. v. Teleflex Inc.* (KSR, 82 USPQ2d at 1396) forecloses the argument that a specific teaching, suggestion, or motivation is required to support a finding of obviousness. See the recent Board decision *Ex arte Smith*, --USPQ2d--, slip op. at 20, (Bd. Pat. App. & Interf. June 25, 2007).

Official notice is taken that it is old and well known to use credit cards for paying for various goods or services instead of using checks or money orders.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Synesiou et al. and Sloan to include that the financial institution processes the card charge request from the utility meter regardless of whether the card charge request relates to any utility usage measurements made by the utility meter for the benefit of convenience.

Claims 28 and 35. Synesiou et al. teaches a utility transaction authorization method, comprising:

- providing a user interface unit (display unit) at a location (C. 5, L. 15-24, 44-60);
- providing a utility meter at the location, the utility meter having an associated meter location identifier uniquely identifying the location (C. 4, L. 16, 30-36);

- accepting a funds card charge authorization request via the user interface unit (C. 5, L. 52-57), the transaction authorization request including:

- (1) data identifying a credit/charge card account (C. 5, L. 55-57), and
  - (2) data identifying the credit/charge card account of the credit/charge card (C. 5, L. 55-57),

- communicating the card charge authorization request from the user interface unit to the utility meter (C. 5, L. L. 34-37); and

- transmitting a message generated in dependence on the card charge authorization request (C. 5, L. 52-57) and meter location identifier (the utility meter

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unique identification number and module address code is stored in microcontroller 68, which allows the consumption data derived from a particular consumer site to be related to that site and to the credit data corresponding to that site) (C. 4, L. 49-53) from the utility meter to a financial institution to obtain authorization of the card charge (C. 5, L. 52-57).

Synesiou et al. does not specifically teach that said data related to the credit/charge card is data indicating that the credit/charge card is physically present at the location of the user interface unit. Also, Synesiou does not teach that the financial institution processes the card charge request from the utility meter regardless of whether the card charge request relates to any utility usage measurements made by the utility meter.

Sloan et al. (Sloan) teaches a prepayment system for dispensing utilities using mag-stripe cards, including a means for reading a mag-stripe card provided at the customer's side (premises) for allowing to dispense utility services in accordance with the value and account information encode' on the mag-stripe card (Cls. 3, 4), wherein the fact of using the mag-card (obtaining data from the mag-card) at the customer premises indicates that the mag-card (credit/charge card) is physically present at the location of the user interface unit.

In this case, each of the elements of the cited references combined by the Examiner performs the same function when combined as it does in the prior art. Thus, such a combination would have yielded predictable results. *See Sakraida*, 425 U.S. at 282, 189 USPQ at 453. Therefore, Supreme Court Decision in *KSR International Co. v. Teleflex Inc.* (KSR, 82 USPQ2d at 1396) forecloses the argument that a specific teaching, suggestion, or motivation is required to support a finding of obviousness. See the recent Board decision *Ex arte Smith*, --USPQ2d--, slip op. at 20, (Bd. Pat. App. & Interf. June 25, 2007).

Official notice is taken that it is old and well known to use credit cards for paying for various goods or services instead of using checks or money orders.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Synesiou et al. and Sloan to include that the

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financial institution processes the card charge request from the utility meter regardless of whether the card charge request relates to any utility usage measurements made by the utility meter for the benefit of convenience.

Dependent claims

Claims 2-4, 7, 8-12. Synesiou et al. teaches a communication unit arranged to communicate with the utility and the financial institution (C. 5, L. 52-57).

Claims 5 and 6. Synesiou et al. teaches said system in which said further meter is a gas or water meter (Fig. 5).

Claims 14-16. Synesiou et al. teaches said system in which RF signals are utilized for communication between communication devices (C. 5, L. 34-37).

Claims 17-21, 23, 36, 38-41. Same reasoning as applied to independent claims 1, 35 and 37.

**Claims 13 and 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Synesiou et al. in view of Sloan et al. further in view of Official Notice and further in view of Bos (WO 00/58922).**

Dependent claims

Claim 13. The combination of Synesiou and Sloan in view of Official Notice teaches all the limitations of claim 13, except that the user interface unit is a telephone.

Bos teaches a utility transaction authorization system, including a meter and a digital cellular phone which is used by a consumer to obtain payment authorization (Fig. 1; Abstract).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the combination to include that the user interface unit is

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a telephone, as disclosed in Bos, because it would advantageously allow to combine various functionalities in one mobile device, thereby providing convenience to the user.

Claims 24-26. Same reasoning applied to claim 13.

**Claims 43-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Synesiou et al. in view of Sloan et al.**

Independent claims

Claims 43-45. Synesiou et al. teaches a utility transaction authorization system, comprising:

- a utility meter (remote measurement module 38) provided at a location having an associated location identifier (unique identification number) unique to the location (C. 4, L. 16, 30-36);

- a user interface unit (display unit) capable of accepting a card charge authorization (C. 5, L. 15-24, 44-60);

- said user interface unit: includes means for inputting credit card information (C. 5, L. 55-58);

- communicating with the utility meter to obtain the location identifier (C. 4, L. 16-36);

- processing the data read from the credit/charge card in combination with the location identifier to form at least a part of the funds transfer authorization to verify that the credit/charge card is physically present at the location of the utility meter (C. 5, L. 52-57), meter location identifier (the utility meter unique identification number and module address code is stored in microcontroller 68, which allows the consumption data derived from a particular consumer site to be related to that site and to the credit data corresponding to that site) (C. 4, L. 49-53), and a secret code or PIN allocated to the consumer (C. 5, L. 53-54)).

Synesiou et al. does not specifically teach that said means for inputting credit card information includes a card reader device.



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Sloan et al. (Sloan) teaches a prepayment system for dispensing utilities using mag-stripe cards, including a means for reading a mag-stripe card provided at the customer's side (premises) for allowing to dispense utility services in accordance with the value and account information encode' on the mag-stripe card (Cls. 3, 4).

In this case, each of the elements of the cited references combined by the Examiner performs the same function when combined as it does in the prior art. Thus, such a combination would have yielded predictable results. See *Sakraida*, 425 U.S. at 282, 189 USPQ at 453. Therefore, Supreme Court Decision in *KSR International Co. v. Teleflex Inc.* (KSR, 82 USPQ2d at 1396) forecloses the argument that a specific teaching, suggestion, or motivation is required to support a finding of obviousness. See the recent Board decision *Ex arte Smith*, --USPQ2d--, slip op. at 20, (Bd. Pat. App. & Interf. June 25, 2007).

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-21, 23-26, 28, and 35-45 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Igor Borissov whose telephone number is 571-272-6801. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Igor N. Borissov/

Primary Examiner, Art Unit 3628

07/05/2009